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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/070,601      | 02/28/2002  | Akihiro Kuroda       | 3094-39             | 7638             |

7590

12/17/2003

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| EXAMINER |
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YU, GINA C

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| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 12/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/070,601

Applicant(s)

KURODA ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 12 recites the broad recitations trimethylsiloxysilicate and dimethylsiloxy group, and the claim also recites MQ resins and MDQ resins, respectively, which are the narrower statement of the limitations.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1, 3- 9, 12, 15,19-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Suzuki (US 5061481) in view of Sakuta (US 4970252).

Suzuki teaches a composition comprising methylphenylpolysiloxane (nonvolatile low viscosity silicone oils, of instant claims 3, 6, and 7) and dimethylpolysiloxane, both having viscosity of 10 cs; acryl-silicone graft copolymer and partially cross-linked organopolysiloxane polymer (instant claims 8 and 12). See Example 11. The example

also contains a composition comprising titanium dioxide in Example 12. See instant claims 20 and 24. The reference also teaches that the invention is a composition comprising volatile silicone oils such as octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane. See col. 11, lines 3 – 8; instant claims 3-5. The reference teaches that any silicone oils having a viscosity below 50 cs can be used as the low viscosity silicone oil. See col. 5, lines 31 – 43. The reference further teaches that perfluoroalkyl(methyl)acrylates can be also used to form the acryl-silicone graft copolymer of instant claims. See, col. 3, line 58 – col. 4, line 17. See instant claim 19.

While the reference teaches that any liquid silicone oil can be used the reference and particularly mentions octa- and deca-methylcyclopentasiloxanes, dimethylpolysiloxane, and methylphenylpolysiloxane, the reference fails to particularly mention the organopolysiloxane of formula (I) of instant claims 1 and 24 (methlytris(trimethylsiloxy)silane). See col. 5, lines 31 – 42. The reference teaches that 2 or more of low viscosity silicone oils can be used in combination if necessary. See col. 6, lines 44 – 48.

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is comparable substitute for other low viscosity silicone oil also well known in the art. Methlytris(trimethylsiloxy)silane is said to have 1 mm<sup>2</sup> /s (cSt). See col. 4, lines 16 – 35. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Suzuki by adding methytris(trimethylsiloxy)silane as motivated by Suzuki and Sakuta because of the expectation of successfully producing a similar cosmetic composition.

Alternatively, it is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of two conventional low viscosity silicone oils well known in cosmetic art. It would follow that the recited claims define prima facie obvious subject matter.

2. Claims 1, 8, 9, 12, 20, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Mellul (US 5496554) in view of Sakuta (US 4970252).

Mellul teaches cosmetic composition comprising a silicone gum, a silicone wax, and a silicone resin, and low-viscosity silicone oil. See col. 3, line 1 – col. 5, line 21; Example 4. The reference teaches using silicone polysiloxane gums having MW of 200K-1000K, and particularly mentions to use polymethylsiloxanes. See col. 3, lines 31 – 49. See instant claims 8 and 9. Example 4 also contains mica and talc. The reference in col. 5, lines 55 – 58 also teaches iron oxides, which are well known UV screening agents. See instant claims 20, 21, and 24. The reference also teaches trimethylsiloxysilicate in the compositions. See Examples; instant claims 8 and 12.

Mellul fails to teach the silicone oil of instant claim 1, formula (I).

Sakuta ('252), as discussed above, teaches methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Mellul by substituting the low viscosity silicone oil with methlytris(trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

3. Claims 1, 8, 10, 11, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Gers-Barlag (US 6436413 B1) in view of Sakuta (US 4970252).

Gers-Barlag teaches a cosmetic emulsion comprising Aerosil R97s (polyalkylsilsesquioxane particles). See Examples; col. 10, lines 39 – 49. The reference also teaches low viscosity silicone oils such as octamethylcyclotetrasiloxane, hexamethylcyclotrisiloxane, polydimethylsiloxane, polymethylphenylsiloxane are useful in oily phase. Example 3 contains titanium dioxide, glycerine, and xanthan gum. See instant claims 20-24.

The reference fails to teach the silicone compound in claim 1, formula (I).

Sakuta ('252) teaches methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Mellul by substituting the low viscosity silicone oil with methlytris (trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

4. Claims 1, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Sakuta (US 6503519 B1) ('519) in view of Sakuta (US 4970252) ('252).

'519 teaches a cosmetic composition comprising a crosslinked silicon polymer and a low viscosity silicone oil having viscosity of less than 100 cSt. See abstract. See instant claims 15 and 17. In claim 17, the "swollen" state of the crosslinked silicone polymer would necessary occur in the composition having the low viscosity silicone oil. The reference teaches that the organohydrogenpolysiloxanes are prepared from polyoxyalkylene having a Si-H bond and a polyoxyalkylene having 2 alkylenes per mole. See col. 5, lines 64 – col. 58. See instant claims 16 and 17. The reference fails to teach the compound of instant claim 1, formula (I).

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition '519 by substituting the low viscosity silicone oil with methlytris (trimethylsiloxy) silane as motivated by '252 because of the expectation of successfully producing a similar cosmetic composition.

5. Claims 1, 3, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 6395857 B1) in view of Sakuta ('252).



Suzuki teaches a cosmetic composition comprising amino-modified silicone, used as a gelling agent for low-viscosity silicone oil. See abstract; col. 4, lines 1-28. See instant claims 13 and 14. Example 1 teaches that the amino-modified silicone has viscosity of 100 cSt at 25 °C. See instant claim 3. While the reference teaches that any liquid silicone oil can be used the reference and particularly mentions octa- and decamethylcyclcopentasiloxanes, dimethylpolysiloxane, and methylphenylpolysiloxane, the reference fails to particularly mention methlytris (trimethylsiloxy) silane. See col. 5, lines 1 – 11.

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Suzuki by substituting the low viscosity silicone oil with methlytris(trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

### ***Conclusion***

No claims are allowed.

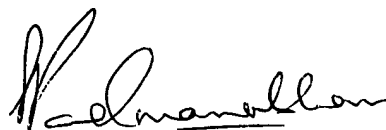
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

12/15/03